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### REMARKS

In the Final Office Action, the Examiner noted that claims 1-10, 13, and 31-32 are pending in the application, and that claims 1-10, 13, and 31-32 are rejected. By this response, claim 31 is amended. Claims 1-10, 13, and 32 continue unamended. In view of the above amendments and the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. § 103. Thus, the Applicant believes that all of these claims are now in condition for allowance.

Notably, Applicants thank the Examiner for expressing his willingness to speak with Applicants' representative, Mr. Robert M. Brush, regarding the Final Office Action. Although a telephonic interview has been scheduled between the Examiner and Mr. Brush on March 22, 2004, Applicants appreciate that the Examiner may not have reviewed the present response in full before such date. Accordingly, Applicants, by way of representation by Mr. Brush, look forward to speaking with the Examiner at a time when the Examiner has reviewed the present response.

### I. OBJECTIONS

The Examiner has objected to claim 31 due to informalities. In particular, the Examiner noted that the limitation "as the sum of a plurality of helper hotness ratings" appears to be erroneously stated twice in succession.

Applicants have amended claim 31 to correct the typographical error. As such, Applicants respectfully request that the objection be withdrawn.

### II. REJECTION OF CLAIMS UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 1-13 as being unpatentable over Eyal (United States patent 6,484,199, issued November 19, 2002) in view of Herz (United States patent 6,029,195, issued February 22, 2000). The rejection is respectfully traversed.

The Examiner's use of the Eyal patent as prior art against Applicants' invention, by itself, is improper. More specifically, the Eyal patent was filed on March 22, 2002, and is a continuation of United States patent 6,389,467, filed May 2, 2000 (the '467

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patent). The present application was filed on March 29, 2000. Since the filing date of the present application precedes the filing date of the Eyal patent, as well as the filing date of the '467 patent, the Eyal patent is not prior art to Applicants' invention.

Applicants note that the Eyal patent claims priority to a provisional patent application filed January 24, 2000 (hereinafter referred to as the "Eyal provisional application"). Under 35 U.S.C. §102(e), the filing date of a provisional patent application may be the effective filing date of a United States patent claiming priority to such provisional patent application only to the extent that such provisional patent application supports the subject matter used to make the rejection. See MPEP §706.02(f). Thus, the Examiner must provide some evidence that the Eyal provisional application supports the subject matter of the Eyal patent used in the rejection.

In the Final Office Action, the Examiner stated that "[i]f the Applicant wishes to challenge the validity of the provisional application related to the Patent utilized as prior art, it is the Applicant's responsibility to provide and specifically point out where in the provisional application the art is not analogous with the Patent utilized in the rejection." (Final Office Action, p. 5). Applicants, however, are not challenging the validity of the Eyal provisional application. Rather, the Applicants are questioning whether the Eyal provisional application contains the subject matter used by the Examiner in the rejection.

Notably, there is no prohibition against the inclusion of subject matter in a non-provisional patent application that was not described in a prior provisional application to which the non-provisional application claims priority. That is, a non-provisional patent application may include new material not described in the provisional application. It is axiomatic that such new material does not receive the benefit of the provisional application. Applicants are not aware of any law, rule, or otherwise that all subject matter described in a patent is presumed to be described in a provisional to which the patent claims priority. Thus, it is possible that the subject matter in the Eyal patent relied on by the Examiner is not described in the Eyal provisional application (i.e., the subject matter in the Eyal patent relied on by the Examiner may constitute new material with respect to the Eyal provisional application). In such a case, the cited subject matter

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would not constitute prior art to Applicants invention. Therefore, in order to set forth a prima facie case, the Examiner must provide evidence that the Eyal provisional application supports the subject matter of the Eyal patent used by the Examiner in the rejection.

In addition, when prior art is cited, the Office action must explain the pertinence of such prior art to Applicants invention as claimed. MPEP §707.05. While the Examiner cited the Eyal patent and the pertinent portions thereof in the Final Office Action, the Examiner did not cite the Eyal provisional application. Nor did the Examiner cite the pertinent portions the Eyal provisional application that support the subject matter in the Eyal patent used in the rejection. Moreover, "[c]opies of cited references...[must be] automatically furnished without charge to applicant together with the Office action in which they are cited." MPEP §707.05(a). The Examiner has not provided Applicants with a copy of the Eyal provisional application in any office action issued thus far. Therefore, Applicants respectfully submit that use of the Eyal patent is improper without providing the Eyal provisional application and an explanation of the pertinent portions thereof.

As discussed above, Applicants do not admit that the Eyal patent by itself is prior art to Applicants' invention. Applicants will now address the present rejection under 35 U.S.C. §103 with respect to the Herz patent. Herz teaches a system that constructs a profile for an object within an electronic medium. (See Herz, Abstract). In particular, Herz describes multicasting between a proxy server and a plurality of servers. (Herz, col. 45, lines 13-33). Herz, however, does not teach, suggest, or otherwise render obvious Applicants' invention as recited in claim 1. Namely, Herz does not teach or suggest calculating a server hotness rating for streaming multimedia objects hosted by a content server. In addition, Herz does not teach or suggest categorizing the streaming multimedia objects into a plurality of hotness categories based on the calculated hotness ratings. Specifically, Applicants' claim 1 positively recites:

"A method for distributing a streaming multimedia (SM) object in a network having a content server which hosts SM objects for distribution over said network through a plurality of helpful servers (HSs) to a plurality of clients, said method comprising:

calculating at said content server a server hotness rating for said SM

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objects hosted thereon;

performing a categorization process, wherein each of said SM objects hosted by said content server are categorized into one of a plurality of server hotness categories based on each of said SM object's calculated server hotness rating; and

multicasting from said content server at least one of said SM objects hosted thereon to a fraction of said plurality of HSs in the network, said fraction being determined according to said SM object's hotness category." (Emphasis added).

Therefore, Applicants contend that claim 1 is patentable over Herz and, as such, fully satisfies the requirements of 35 U.S.C. §103.

Furthermore, claims 5, 9, and 13 recite features similar to those recited in claim 1. For the same reasons discussed above, Applicants contend that claims 5, 9, and 13 are also patentable over Herz and fully satisfy the requirements of 35 U.S.C. §103. Finally, claims 2-4, 6-8, and 10 depend, either directly or indirectly, from claims 1, 5, 9, and 13 and recite additional features therefor. Since Herz does not render obvious Applicants' invention as recited in claims 1, 5, 9, and 13, dependent claims 2-4, 6-8, and 10 are also not obvious and are allowable.

### CONCLUSION

Thus, Applicants submit that none of the claims presently in the application are obvious under the provisions of 35 U.S.C. § 103. Consequently, Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Robert M. Brush, Esq. or Mr. Eamon J. Wall, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

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Respectfully submitted,

3/12/04

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